

## Reissue Declaration

A SUPPLEMENTAL DECLARATION AND POWER OF ATTORNEY is hereby submitted on behalf of the inventor.

### Claim Rejections - 35 USC § 251

The rejection of claims 9-21 under Rejections Under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based is traversed as unsupported.

First and foremost, the Examiner's position is contrary to 37 C.F.R. 1.109 *Reasons for Allowance*. That Regulation states:

If the Examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing the claim or claims, the Examiner set forth such reasoning. The reasons shall be incorporated into an Office action rejecting other claims... or be the subject of a separate communication to the applicant or patent owner. The applicant or patent owner may file a statement commenting on the reasons for allowance within such time as may be specified by the Examiner. **Failure to file such a statement shall not give rise to any implication that the applicant or patent owner agrees with or acquiesces in the reasoning of the Examiner.** (Emphasis added.)

The only basis in the file history the Examiner is relying upon for acquiescing is Applicant's lack of a response to the Examiner's stated reason for allowance. Under 37 C.F.R. 1.109 as quoted above, neither the Examiner nor the public can rely upon the Applicant's non-response to a stated reason for allowance as an acquiescence to the Examiner's position. Accordingly, the sole basis relied upon by the Examiner for his imposition of the recapture rule is expressly prohibited by regulation. In the absence of other support from the Examiner for his position, the issue of recapture is unsupported in this case.

It is further expressly noted that the Examiner's reliance on a portion of his stated reason

for allowance, “the combination *of all of the features claimed in claim 7*”, is taken out of context and is meaningless by itself. The Examiner is by rule and regulation required to consider a claim “as a whole” in determining its patentability. This includes all of its claimed features. What is more telling is the quoted portion of the reason for allowance he chooses now not to emphasize, namely “in particular with the use of two stops on the coupling head for limiting the pivotal movement of the coupling knuckle against the spring....” This is the express language of original application claim 4, which was never rejected over the prior art and for which Applicant never argued or had need to argue for patentability.

Even more relevant is the remainder of the stated reason for allowance that the Examiner does not rely upon or even quote, namely “....is not found or suggested by any of the prior art of record, including the exhibits of the protest filed 10/10/95.” A third party protest to the granting of a patent on this application was filed while the application was pending. It is nowhere reflected in the file history of this application before its acknowledgement by the Examiner here in the reasons for allowance. When considered as a whole, it is clear that the reason for the Examiner’s inclusion of a statement of the reasons for allowance was not to warn applicant that he (the Examiner ) was relying upon all of the elements of application claims 4 and 7 for allowance but to give notice that he considered the patentability of claims against the prior art of the protest, neither expressly cited nor made of record in the application, and still found the claims, “ in particular” with the feature of originally allowed claim 4, to be allowable over this art.

It is further expressly noted that the Examiner did not simply invite the applicant to “submit any comments considered necessary.” Unfortunately for the Examiner’s primary argument right now, the Examiner expressly invited the applicant to submit “any comments

considered necessary **by applicant....**” (Emphasis added.) The form of the Examiner’s invitation makes applicant the sole determiner of what was considered necessary for response. The Examiner cannot now complain that the Examiner now thinks it was necessary that comments should have been made by the Applicant under the circumstances.

Moreover, if the Examiner now believes the applicant should have commented on the Examiner’s reference to “(t)he combination of all the features claimed in claim 7”, he should indicate why the applicant would be expected to reply to that particular statement.

First, the Examiner is expected to review all claims for allowability over the prior art under 35 USC §§ 102 and 103. Under MPEP 2141, the Examiner **must** consider “the claimed invention...as a whole.” This means he must consider all of the elements/features of the claims. Indeed, he is not permitted to consider anything less. So what does the Examiner expect the applicant to contest when the Examiner expressly states that he has done what he was supposed to do? That the Examiner must not or should not consider the claims as a whole?

Second, there was no substantive reason for the applicant to have responded under the circumstances. The Examiner’s statement that all the features of claim 7 were not found in the prior art was obvious from the prior art and the file history. The examiner had found all of the features of application claim 1 from which claim 4 depended and repeatedly rejected that claim. He also allowed claim 4 in his first action and repeated his allowance in each subsequent action. He never referred to the features of claim 4 being found in any of the prior art of record. The file history clearly discloses these reasons for allowance of application claims 4 and 7 becoming patent claim 1.

Moreover, the Examiner’s attempt to now rely upon a statement of reasons for allowance and, in particular, a portion that merely recites what the Examiner is required to do in examining

allowed claims, to deny applicant the rights under 35 USC §251 he would have otherwise been entitled to, denies applicant equal protection under the law. When applicant's patent first issued, it was immediately endowed by law with a presumption of validity. That means it was legally presumed to have been examined and allowed according to law and to the rules and regulations relating to examination. It further means specifically that the Examiner is presumed to have considered each of the allowed claims as a whole and found them not to be obvious over the prior art. Patentees whose applications are allowed without an express restatement of the rules under which the Examiner must examine and allow claims are not required to file any statement contesting the allowance of their claims in order to preserve their right to seek a broadening reissue examination. If that were the case, there effectively would be no grounds ever for a broadening reissue. Denying applicant his statutory right to a broadening reissue merely because the Examiner recites that he has done what he is supposed to do denies applicant the same protection afforded patent owners whose examiners are not so "helpful".

Furthermore, the recapture rule is supposed to be an equitable doctrine. Why does the Examiner's mere express statement that he has done what he is supposed to do in examining and allowing claims, and nothing more, constitute grounds to treat this applicant differently from any other patentee who has his claims allowed without a restatement of the criteria for examination? The failure to treat the applicant herein the same way as a patent in which the claims are allowed without an express restatement of the criteria for allowance, is inequitable as well as unequal.

Even if the Examiner's position were correct and applicant should be considered to have had an obligation to respond to the stated reasons for allowance, and was therefore subject to the provisions of the recapture rule, the Examiner has not made a case that the presently rejected claims 9-21 improperly recapture surrendered subject matter.

*In re Clement* clearly indicates that the determination of recapture is a two step process.

45 USPQ2d 1161, 1164:

The first step in applying the Applicant is determine whether and in what “aspect” the reissue claims are broader than the patent claims. For example, a reissue claim that deletes a limitation or element from the patent claims is broader in that limitation’s aspect. ... Under *Mentor*, courts must determine in which aspects the reissue claim is broader, which includes broadening as a result of an omitted limitation.

The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection.

If any broadening, including that which occurs by the deletion of a limitation or element from the patent claim, were absolutely prohibited, there would be no need to perform the second step.

That is, there would be no need to determine whether “the broader aspect of the claim relates to the particular subject matter” surrendered. Indeed, in both *Clement* and in *Hester Industries, Inc. v. Stein, Inc.*, the second case cited by the Examiner, the court found not that the mere deletion of an element from allowed claims required recapture but that the specific deletion of elements that were added by amendment to the original independent claims and which were specifically argued to provide patentability over prior art cited to originally reject those claims could not now be removed or even broadened from the form in which the original claims were allowed. Neither decision relates to the present situation where applicant is seeking the removal of an element not relied upon by the applicant to obtain allowance of the claims in question. The Examiner has not performed the second step of the process for applying the Applicant that is required by the references he is relying upon.

Indeed, in *Ball*, the third case relied upon by the Examiner, the court found that the

Applicant did not apply. That case is factually more closely related to the present application than either *Clement* or *Hester*. In *Ball*, an independent application claim 7 and a dependent claim 8 were rejected in a first Office Action over the prior art while a dependent claim 9 was indicated to be allowable. Claim 8 called for “at least one” conductive lead while claim 9 required “a plurality of leads”. After the claims were amended in other ways, the Examiner repeated the rejection of claim 8 again and indicated the allowability of the plurality of feed line claims if presented in independent form. The claims were again amended to require “a plurality of leads...” and were subsequently allowed. In the reissue application, filed within two years of the grant of the original patent, the applicant presented new claims which eliminated the requirement for a “plurality of leads”. Despite this change, the court still found that the granted reissue claims were sufficiently narrower than the cancelled claims to avoid the recapture rule. *Ball Corp. v. United States*, 221 USPQ 289, 292.

*Ball* is further pertinent in that the court distinguishes the significant difference between the two year broadening rule under the statute (35 USC 251) and the Applicant:

Thus, the principle that a claim is broadened if it is broader in any respect than the original claim serves to effect the bar section 251 against reissue file later than 2 years after issuance of the original patent. In this case, *Ball* filed its application for reissue within the two-year period for broadening reissue specified in section 251. 221 USPQ2d at 225.

So did applicant. *Ball* goes on to state:

We know of no authority applying the above rule to reissue claims relative to the scope of canceled claims within the 2-year period for broadening reissue. Nor do we perceive the wisdom of such extension in this case. The rule is rigid and properly so in that it effects an express statutory limitation on broadening reissue. The Applicant, however, is based on equitable principles. **The rigidity of the broader-in-any respect rule makes it inappropriate in the estoppel situation presented in this appeal.** (Emphasis added.)

Here, the Examiner is merely arguing the broader in any respect rule as being controlling respect to a recapture determination.

There is no evidence anywhere in the file history that either the applicant or the Examiner ever knowingly considered the scope of the invention as represented by claim 1 of the present patent. It was indicated to be allowable over the prior art at the beginning of the prosecution and basically ignored by applicant and the Examiner while the applicant pressed his arguments for the allowance of original independent application claim 1. There is no evidence anywhere in the prosecution that applicant intended to abandon any claim that included the limitation of application claim 4 or that the applicant or the Examiner considered in the original application any claims identical or equivalent to claims 9-21 of the present reissue application.

These arguments further apply to the changes the Examiner is demanding be made to claim 9, claims 10-15, claims 16-21, claims 16, 18-21 and claim 17 on pp. 4-5 of the Detailed Action.

Accordingly, reconsideration and withdrawal of the rejections of claims 9-21 under 35 USC 251 and the recapture rule are respectfully requested.

#### **Finality of Pending Action**

Finally, reconsideration and withdrawal of the finality of the presently pending action is respectfully requested. According to MPEP 706.07(a):

**Under present practice, second or any subsequent actions on the merits shall be final, except where the Examiner introduces a new ground of rejection not necessitated by amendment of the application by applicant, whether or not the prior art is already of record.**

Here, the Examiner has raised a new rejection of previously allowed claim 5 under 35 U.S.C. 112, second paragraph. Since this rejection is being raised for the first time and is not being

raised in response to any amendment made to the claim by the applicant, final rejection of the application is not appropriate, even if the claims are being rejected over the same prior art for the second time.


### **Conclusion**

For the foregoing reasons, reconsideration and withdrawal of the finality of the prior action, entry of the amendment, reconsideration and withdrawal of the various rejections and allowance of the reissue application are respectfully requested.

Respectfully submitted,

**ROBERT H. STAAT**

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(Date)

By:   
**JOHN JAMIESON, JR.**  
Registration No. 29,546  
**AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P.**  
One Commerce Square  
2005 Market Street - 22nd Floor  
Philadelphia, PA 19103  
Telephone: (215) 965-1200  
**Direct Dial: (215) 965-1310**  
Facsimile: (215) 965-1210  
E-Mail: [jjamieson@akingump.com](mailto:jjamieson@akingump.com)